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09/874,010	06/06/2001	Shigeharu Nakagawa	P56332	7488

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EXAMINER

BROWN, TIMOTHY M

ART UNIT PAPER NUMBER

1648

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/874,010

Applicant(s)

NAKAGAWA, SHIGEHARU

Examiner

Timothy M. Brown

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

In view of the Appeal Brief filed on January 7, 2005, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 44 is indefinite in that there is no antecedent basis for "the destination" in line 7. Claim 64 is indefinite in that there is no antecedent basis for "the document" in line 14.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claims 45-53 and 64-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Gross et al. (US 6,918,082).***

Applicant claims an Internet printing apparatus comprising a printing agency server, a memory having stored thereon a customer's choice of attributes for a print job, an editor connected to said first memory, and an output device connected to said first memory. Gross et al. disclose an electronic proofing system comprising a document server, a database, and an output device (see Figs. 1 and 2; and col. 8, lines 64-68). Note that this rejection does not give weight to the remainder of the claim limitations because they are intended use for the claimed apparatus. Because the Gross et al. apparatus is capable of performing the intended use, Gross et al. anticipates the claimed subject matter.

***Claims 45-53 and 64-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Vogt et al. (US 6,611,349).***

Applicant claims a printing apparatus as noted above. Vogt et al. disclose printing a publishing system comprising a document server, a database, and an output

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device (see Fig. 5). Note that this rejection does not give weight to the remainder of the claim limitations because they are an intended use for the claimed apparatus. Because the Gross et al. apparatus is capable of performing the intended use, Gross et al. anticipates the claimed subject matter.

Note that if claims 45-53 and 64-71 were interpreted to require the functional limitations recited, these claims would have been an obvious modification of the references discussed below.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 6,918,082 B1) in view of Sevcik et al. (US 6,330,542).***

Applicant claims a method a method for printing a document comprising a offering a printing service, receiving, by a merchant from a customer, a request for quote (RFQ) for a print job, said merchant issuing an estimate for said print job, receiving from the customer a first draft of the print job, said merchant editing said first draft and providing said edited first draft to the customer, generating a revised draft based on said edited first draft, and outputting said revised draft to a remote output device.

Gross et al. disclose a method for providing a printing service comprising a customer creating a draft document (col. 3, lines 54-55, 59-60), a proofer at a printing merchant receiving said draft (col. 3, lines 55-57), said proofer reviewing the draft and commenting on said draft (col. 4, lines 6-11), sending said draft and comments to the

customer and said customer revising said draft and returning said revised draft to said printing service (col. 4, lines 25-42), and sending the revised draft to a printing agency for printing (col. 4, lines 42-47).

Gross et al. do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer. However, Sevcik et al. teach a method for issuing a cost estimate for a printing job comprising displaying to a customer a catalog of print services (Fig. 1A, char. 32), receiving from said customer a selection of print services including item specific options (Fig. 1A, char. 63), and issuing to said customer a cost estimate based on said customer selection (Fig. 1A). At the time of Applicant's invention, it was well known that a quoting process could be used to price services. This would have been very desirable for a printing service such as Gross et al.'s since the variation between customer print jobs prevents a standard price structure. Thus, it would have been obvious to one skilled in the art provide Gross et al.'s service with Sevcik et al.'s quoting process in order to provide a price for custom print jobs.

Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method since the method is designed to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, this distinction does not make Applicant's method patentable as it would have been obvious to make this change. At the time of Applicant's invention, it was customary for a customer (i.e. contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience. Thus, it would have been obvious to allow Gross et al.'s customer to select the remote output device as provided in the claims.

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Applicant's method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction. The Examiner submits at the time of Applicant's invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

Applicant's method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility. The Examiner submits it would have been obvious to have Gross et al.'s method include these corrections since Gross et al. is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.

***Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,707,931 B2) in view of Sevcik et al. (US 6,330,542).***

Applicant claims a method as described above. Herbert discloses a method for remotely proofing documents comprising a customer capturing a digital image of a sample (col. 4, lines 53-59; col. 7, lines 43-46), transmitting the digital image to a server (col. 4, lines 57-59), accessing the digital image by a proofreading service provider (col. 5, lines 44-67), the print service provider creating a digital proof based on corrections to said digital image (col. 6, lines 61-64; col. 7, lines 11-18, 47 – col. 8, line 3), sending said proof to the customer for approval (col. 8, lines 1-3), approving or modifying said proof by said customer (col. 7, line 65 – col. 8, line 3), and if approved, sending said proof to a printing agency for printing (col. 7, lines 65-66).

Herbert does not expressly disclose receiving a RFQ and issuing a cost estimate to a customer. However, it would have been obvious to include this feature in view of Sevcik et al. for the reasons discussed above.

Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lens 23-24). This limitation does not change the outcome or effect of the method which is to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, it would have been obvious to include this step as discussed above.

Applicant's method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction. The Examiner submits at the time of Applicant's invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

Applicant's method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility. The Examiner submits it would have been obvious to have Herbert's method include these corrections since Herbert is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.

***Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 6,611,349 B1) in view of Sevcik et al. (US 6,330,542).***

Applicant claims a method as described above. Vogt et al. disclose a method of providing a publishing service comprising a customer creating a document having images and text (Fig. 6, char. 610-640; col. 2, lines 39-40, 43-45; col. 11, lines 35-37),



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forwarding said document to a proofing device over a communication network (Fig. 6, char. 645; col. 11, lines 37-44), said proofing device making revisions to said document and making said revised document available to said customer (Fig. 8B, Char. 850), said customer approving said revised document (Fig. 8B, Char. 850), and providing said revised document to a printing agency (Fig. 6, Char. 655).

Vogt et al. do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer. However, it would have been obvious to include this feature in view of Sevcik et al. for the reasons discussed above.

Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method which is to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, it would have been obvious to include this step as discussed above.

Applicant's method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction. The Examiner submits at the time of Applicant's invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

Applicant's method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility. The Examiner submits it would have been obvious to have Vogt et al.'s method include these corrections since Vogt et al. is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 6,918,082 B1) in view of Sevcik et al. (US 6,330,542) and further in view of "Cowan" (Cowan, L. "Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation" Printing News (May 1999) vol. 142, no. 18, p. 20).***

The invention of these claims further limits the invention discussed above (i.e. claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81) by providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. Although the combination of Gross et al. and Sevcik et al. does not teach selecting a remotely located output device, it would have been obvious to one of ordinary skill in the art to modify Gross et al. and Sevcik et al. to include this feature. Cowan makes it clear that at the time of Applicant's invention, print service providers were allowing customers to select a convenient location for print job pick-up and/or distribution (p. 1). Cowan teaches that allowing customers to select a print location reduces printing charges, saves time and provides extra service. Thus, it would have been obvious to one of ordinary skill in the art to modify Gross et al. and Sevcik et al. to allow a customer to select a printer (i.e. output device) location in order make print services cheaper.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,707,931 B2) in view of Sevcik et al. (US 6,330,542) and further in view of "Cowan" (Cowan, L. "Traditional and On-Demand***

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***Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation" Printing News (May 1999) vol. 142, no. 18, p. 20).***

The invention is interpreted as noted above. Herbert and Sevcik et al. do not expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. However, for the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify Herbert and Sevcik et al. to include Cowan's teaching of a remotely located output device.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 6,611,349 B1) in view of Sevcik et al. (US 6,330,542) and further in view of "Cowan" (Cowan, L. "Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation" Printing News (May 1999) vol. 142, no. 18, p. 20).***

The invention is interpreted as noted above. Vogt et al. and Sevcik et al. do not expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. However, for the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify the teachings of Vogt et al. and Sevcik et al. to include Cowan's teaching of a remotely located output device.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 6,918,082 B1) in view of Sevcik et al. (US 6,330,542) and further in view of Adamske et al. (US 6,615,234 B1).***

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The invention is interpreted as noted above. The combination of Gross et al. and Sevcik et al. does not teach selecting a remotely located output device. However, Adamske et al. teach a system and method for network-based document delivery wherein a user is allowed to select the destination for picking up the hard copy of a desired document (col. 4, lines 9-39). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Gross et al. and Sevcik et al. to include Adamske et al.'s teaching of permitting the customer to select the delivery location for the document. This combination would increase the value of Gross et al.'s document service by increasing customer convenience.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbert (US 6,707,931 B2) in view of Sevcik et al. (US 6,330,542) and further in view of Adamske et al. (US 6,615,234 B1).***

The invention is interpreted as noted above. Herbert and Sevcik et al. do not expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. However, for the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify the teachings of Herbert and Sevcik et al. to include Adamske et al.'s teaching of a remotely located output device.

***Claims 40-42, 44, 63, 72-74, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 6,611,349 B1) in view of Sevcik et al. (US 6,330,542) and further in view of Adamske et al. (US 6,615,234 B1).***

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The invention is interpreted as noted above. Vogt et al. and Sevcik et al. do not expressly teach providing that the output device is at a location that is separate from the printing agency, and that the customer is allowed to select the location of the output device. However, for the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify the teachings of Vogt et al. and Sevcik et al. to include Adamske et al.'s teaching of the use of a remotely located output device.

***Claims 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 6,918,082 B1) in view of "Cowan" (Cowan, L. "Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation" Printing News (May 1999) vol. 142, no. 18, p. 20).***

Applicant claims a system for printing a document comprising (A) a printing agency server, (B) a printing agency editor capable of (i) editing a manuscript from a user to produce a draft document, (ii) submitting said draft document, and (iii) receiving the customer's revisions to said draft document, and (C) a plurality of output devices located at one or more locations that are separate from said printing agency, wherein said output device is a printer.

Gross et al. disclose a printing apparatus comprising a central computer capable of receiving a document from a user (Fig. 1, char. 60; col. 3, lines 52-57), a proofer computer system in communication with said central computer, wherein said proofer computer is configured to proof user documents (Fig. 1, char. 52; col. 3, line 66 – col. 4, line 5).

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Gross et al. do not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency. However, it would have been obvious to one of ordinary skill in the art to modify Gross et al. to include this feature. Cowan makes it clear that at the time of Applicant's invention, print service providers were allowing customers to select a printing location for convenient pick-up or distribution. (p. 1). Cowan teaches that allowing customers to select a print location reduces printing charges, saves time and provides extra service. Thus, it would have been obvious to one of ordinary skill in the art to modify Gross et al. to allow a customer to select a printer location (i.e. output device) in order to offer printing services at a lower cost.

***Claims 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross et al. (US 6,918,082 B1) in view of Adamske et al. (US 6,615,234 B1).***

Applicant's system is interpreted as noted above. Gross et al. do not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency. However, Adamske et al. teach a system for network-based document delivery wherein a user is allowed to select the destination for picking up hard copies of a desired document (col. 4, lines 9-39). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Gross et al. to include Adamske et al.'s teaching of a plurality of output devices located at one or more locations separate from the printing agency. This combination would increase the value of Gross et al.'s document service by increasing customer convenience.

***Claims 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 6,611,349 B1) in view of "Cowan" (Cowan, L. "Traditional and On-Demand Printers Say Distributed Printing Saves Time, Money, and Is a Driver of Industry Consolidation" Printing News (May 1999) vol. 142, no. 18, p. 20).***

Applicant's system is interpreted as noted above. Vogt et al. disclose a system architecture for remote printing and publishing services comprising a central service facility server capable of receiving and storing a document from a user (Fig. 1, char. 130; Fig. 6, lines 27-41) and a proofing device for editing user documents (Fig. 4, char. 410; and col. 8, lines 26-46). Vogt et al. do not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency. However, Adamske et al. teach a system for network-based document delivery wherein a user is allowed to select the destination for picking up hard copies of a desired document (col. 4, lines 9-39). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Vogt et al. to include Adamske et al.'s teaching of a plurality of output devices located at one or more locations separate from the printing agency. This combination would increase the value of Vogt et al.'s document service by increasing customer convenience.

***Claims 64-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 6,611,349 B1) in view of Adamske et al. (US 6,615,234 B1).***

Applicant's system is interpreted as noted above. Vogt et al. disclose a system architecture for remote printing and publishing services comprising a central service facility server capable of receiving and storing a document from a user (Fig. 1, char.

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130; Fig. 6, lines 27-41) and a proofing device for editing user documents (Fig. 4, char. 410; and col. 8, lines 26-46). Vogt et al. do not expressly disclose a plurality of output devices located at one or more locations separate from the printing agency. However, Adamske et al. teach a system for network-based document delivery wherein a user is allowed to select the destination for picking up hard copies of a desired document (col. 4, lines 9-39). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art to modify Vogt et al. to include Adamske et al.'s teaching of a plurality of output devices located at one or more locations separate from the printing agency. This combination would increase the value of Vogt et al.'s document service by increasing customer convenience.

### ***Summary of Art Rejections***

In summary, Applicant's invention is a consolidation of basic printing services. That is, Applicant's invention simply adds quoting and proofreading to a run-of-the-mill online print service. At the time of Applicant's invention, providing a quote was the obvious means for giving customers an idea of how much a custom service would cost. Proofreading (i.e. editing) was the accepted means for improving document quality and preventing errors. Therefore, providing the cited online print service references with the basic steps of quoting and proofreading would have been obvious to one of ordinary skill in the art.



**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy M. Brown  
Examiner  
Art Unit 1648

tmb

  
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